

**REMARKS REGARDING REJECTIONS AND AMENDMENTS TO THE
CLAIMS**

Notice of Non-Compliant Amendment - from the Examiner December 5, 2005

The Examiner has stated in the Office Action of December 5, 2005, that Each claim has not been provided with the proper status identifier. Your applicant has set out the claims with the Status Identifiers as indicated in the Examiner's Action. Your applicant respectfully requests that this Amendment and Response be found to abide with the requirements of the Action and to allow the claims to be prosecuted on the merits.

The Examiner, in Continuation of 4(e) Other, notes that none of the Amendments and Responses have been entered for 3/18/05, 5/31/05, 6/7/05 and 9/19/05. Your applicant has addressed each of the indicated Amendments and Responses and respectfully requests that prosecution of this application proceed on the merits.

The Examiner has noted in particular claim 8. Your applicant believes that the reference has been addressed and asks the Examiner to examiner the application on the merits.

**Claim Rejections under 35 U.S.C. 102(b) FROM OFFICE ACTION 10/18/04 AS
RESPONDED TO 3/18/05**

1. Comments Regarding Foresi: At page 3 of the Examiner's Action OF 10/18/04 the Examiner has rejected Claims 8-9 under 35 U.S.C. 102(b) as being anticipated by Foresi. The Examiner states that Foresi discloses a putter apparatus having an upper shaft (30) with a counter weight in the form of a grip (33) proximal to an end (Fig. 5), and a grip clip means in the form of a clamp affixed with a hinge means at an apparatus upper shaft second end (Fig. 8).

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Floyd E. Ivey in response to Office Action
of December 5, 2005.

1 The Examiner's attention is drawn to Foresi relative to the disclosure and claim of
2 a bend (42) in the elongated member (30). The bend (42) is seen in Foresi at Fig. 3, 4, 5,
3 6, 7 and 8, is described in the Detailed Description at column 4/lines 40-57 and is
4 claimed in Claim 1, column 6/lines 34-38.

5 The invention of your present applicant does not disclose or depict or claim a
6 "bend (42)" corresponding to that of Foresi.

7 Foresi claims, in claim 1, "

8 ...and the curve in the bent section and the angle of the member with respect to the
9 shaft of the putter when rigidly attached thereto being such that the proximal end
10 may be comfortably nestled under the golfer's armpit throughout the
11 pendulum-like swing.

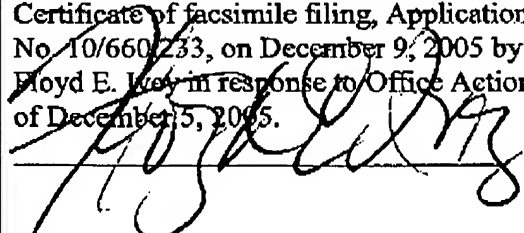
12 The Examiner is referred to the statement of the law under 35 U.S.C. 102, as
13 follows, regarding "... any degree of physical difference between the patented product
14 and the prior art, no matter how slight, defeats the claim of anticipation." *American*
15 *Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D.
16 N.Y. 1994) *infra*.

17 Claim 8 has been amended to state in part "said upper shaft (10) having adequate
18 length to contact the side of the player's neck:" Antecedent basis for this amendment is
19 found at Specification page 2/lines 19-20.

20 The rejection under Foresi has been addressed and the structure and claims of
21 Foresi has been demonstrated to differ from that specified and claimed by your applicant.
22 Accordingly, the Examiner is respectfully requested to withdraw the rejection under
23 Foresi and to allow claims 8 and 9.

24
25 **2. Comments Regarding Smith:** At page 4 of the Examiner's Action the
26 Examiner has rejected Claim 8 under 35 U.S.C. 102(b) as being anticipated by Smith.

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1 The Examiner states that Smith discloses a club apparatus able to be used as a putter
2 having an upper shaft with a counter weight in the form of a grip proximal to an end (Fig.
3 1), and a grip clip means in the form of a clamp affixed with a hinge means at an
4 apparatus upper shaft second end (Figs. 1-2).

5 The Examiner's attention is drawn to Smith relative to the disclosure and claims
6 wherein Smith neither discloses or claims a counter weight. The invention of your
7 present applicant does disclose and claims a "counter weight". The Examiner is referred
8 to the statement of the law under 35 U.S.C. 102, as follows, regarding "... any degree of
9 physical difference between the patented product and the prior art, no matter how
10 slight, defeats the claim of anticipation." *American Permahedge, Inc. v. Barcana, Inc.*,
11 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994) *infra*.

12 The rejection under Smith has been addressed and the structure and claims of
13 Smith have been demonstrated to differ from that specified and claimed by your
14 applicant. Accordingly, the Examiner is respectfully requested to withdraw the rejection
15 under Smith and to allow claim 8.

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17 **3. Comments Regarding Schuster:** At page 4 of the Examiner's Action the
18 Examiner has rejected Claim 8 under 35 U.S.C. 102(e) as being anticipated by Schuster.
19 The Examiner states that Schuster discloses a putter apparatus having an upper shaft (4)
20 with a counter weight in the form of a pad (8) proximal to an end (Fig. 1), and a grip clip
21 means in the form of a clamp (12) affixed with a hinge means at an apparatus upper shaft
22 second end (Figs. 1-2).

23 The Examiner's attention is drawn to Schuster relative to the stated disclosure and
24 or claim of a counter weight. The Examiner equates the "counter weight" of your present
25 invention with a "pad" (8) of Schuster. The pad (8) is seen in Schuster at Fig. 1, 2, 5, 7

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1 and 8, is described in the Detailed Description at column 5/lines 18-20 stating "...

2
3 A forearm cradle pad 8 is mounted coaxial at the bar's curved end, creating a
4 forearm cradle assembly 6.

5 And in claim 10 there is claimed "...said bar contains a pad at its distal end to comfort the
6 player."

7 There is no structural relationship between the "counter weight" of your present
8 invention and the "pad (8)" of Schuster. The "pad (8)" of Schuster is not a weight.

9 The invention of your present applicant does not disclose or depict or claim a
10 "pad". Schuster does not disclose or depict or claim a "weight" corresponding to the
11 counter weight of the present invention. The Examiner is referred to the statement of the
12 law under 35 U.S.C. 102, as follows, regarding "... any degree of physical difference
13 between the patented product and the prior art, no matter how slight, defeats the
14 claim of anticipation." *American Permahedge, Inc. v. Barcana, Inc.*, 857 F. Supp. 308,
15 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994) *infra*.

16 Claim 8 has been amended to state "said upper shaft (10) having adequate length
17 to contact the side of the player's neck;" thereby further distinguishing the present
18 invention from Schuster. Antecedent basis for this amendment is found at Specification
19 page 2/lines 19-20.
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22 The rejection under Schuster has been addressed and the structure and claims of
23 Schuster has been demonstrated to differ from that specified and claimed by your
24 applicant. Accordingly, the Examiner is respectfully requested to withdraw the rejection
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1 under Schuster and to allow claim 8.

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3 Law regarding 35 U.S.C. 102.
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5 A rejection for anticipation under section 102 requires that each and every
6 limitation of the claimed invention be disclosed in a single prior art reference. (*Bristol-*
7 *Myers Squibb Co. v. Ben Venue Laboratories, Inc.*, 246 F.3d 1368, 1374 (Fed. Cir. 2001).
8 A finding of anticipation by summary judgment "is improper if a reasonable jury could
9 find that" not every claim limitation of the patent-in-suit is found in the prior art. *Abbott*
10 *Labs. v. Torpharm, Inc.*, 300 F.3d 1367, 1373 (Fed.Cir.2002). ("[A] claim is anticipated
11 if each and every limitation is found either expressly or inherently in a single prior art
12 reference."); *Celeritas Techs. Ltd. v. Rockwell Intl. Corp.*, 150 F.3d 1354, 1360, 47
13 USPQ2d 1516, 1522 (Fed.Cir.1998). To anticipate, the reference must also enable one of
14 skill in the art to make and use the claimed invention. *In re Donohue*, 766 F.2d 531, 533,
15 226 USPQ 619, 621 (Fed.Cir.1985); *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d
16 1429, 1431 (Fed. Cir. 1997); *Hazani v. U.S. Int'l Trade Comm'n*, 126 F.3d 1473, 1477, 44
17 USPQ2d 1358, 1361 (Fed. Cir. 1997); *Motorola, Inc. v. Interdigital Technology Corp.*,
18 121 F.3d 1461, 43 USPQ2d 1481 (Fed. Cir. 1997); *In re Paulsen*, 30 F.3d 1475, 1478-79,
19 31 USPQ2d 1671, 1673 (Fed. Cir. 1994) ("A rejection for anticipation under section 102
20 requires that each and every limitation of the claimed invention be disclosed in a single
21 prior art reference".) For a prior art reference to anticipate in terms of 35 U.S.C. S 102,
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of December 5, 2005.

1 every element of the claimed invention must be identically shown in a single reference.
2 The elements must be arranged as in the claim under review. (*In Re Bond*, 910 F.2d 831,
3 832, 15 USPQ2d 1566, 1567 (Fed. Cir. 1990).
4

5 Prior art anticipates an invention, rendering it invalid, pursuant to 35 U.S.C. §
6 102, if a single prior art reference contains each and every element of the patent at issue,
7 operating in the same fashion to perform the identical function as the patented product.
8 *Scripps Clinic & Research Found. v. Genentech, Inc.*, 927 F.2d 1565, 1576
9 (Fed.Cir.1991); *Carella v. Starlight Archery & Pro Line Co.*, 804 F.2d at 138. "There
10 must be no difference between the claimed invention and the referenced disclosure, as
11 viewed by a person of ordinary skill in the field of the invention." *Scripps Clinic &*
12 *Research Found. v. Genentech, Inc.*, 927 F.2d at 1576; *see also E.I. du Pont de Nemours*
13 *& Co. v. Polaroid Graphics Imaging, Inc.*, 706 F.Supp. 1135, 1142 (D.Del.1989), *aff'd*,
14 887 F.2d 1095 (Fed.Cir.1989) ("all of the same elements [must be] found in exactly the
15 same situation and united in the same way ... in a single prior art reference") (quoting
16 *Perkin Elmer Corp. v. Computervision, Corp.*, 732 F.2d 888, 894 (Fed.Cir.1984)). Thus,
17 any degree of physical difference between the patented product and the prior art, no
18 matter how slight, defeats the claim of anticipation. *E.I. du Pont de Nemours & Co. v.*
19 *Polaroid Graphics Imaging, Inc.*, 706 F.Supp. at 1142; *American Permahedge, Inc. v.*
20 *Barcana, Inc.*, 857 F. Supp. 308, 32 USPQ2d 1801, 1807-08 (S.D. N.Y. 1994 where it is
21 noted that "Identity requires not only that every element of the claimed invention appear
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1 in a single prior art reference, but that they appear in the same order as in the claims."). It
2 is incumbent upon the examiner to identify wherein each and every facet of the claimed
3 invention is disclosed in the applied reference. (*Ex Parte Levy*, 17 USPQ2d 1461, 1462
4 (Bd. Pat. App. & Int'f 1990)). Viewing "anticipation" from the perspective of
5 infringement, where one accused of infringing "...seeks to practice the prior art, and
6 because that practice infringes, the next logical inquiry involves anticipation. That is, if
7 the prior art infringes now, logically the prior art should have anticipated the claim before
8 the filing of the '723 patent. See *Bristol-Myers Squibb Co. v. Ben Venue Labs., Inc.*, 246
9 F.3d 1368, 1378 (Fed.Cir.2001) (restating the axiom that "that which would literally
10 infringe if later in time anticipates if earlier"). *SmithKline Beecham Corp. v. Apotex Corp.*
11 365 F.3d 1306, 1315, (C.A.Fed., Ill.2004).

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15 Your applicant respectfully contends that such identity is lacking between your
16 applicants invention and the disclosures and claims of the art cited. Your applicant
17 contends that the references must be discounted as anticipating the present invention.

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19 The applicant hereafter demonstrates differences between features of the
20 referenced prior art and the present invention as specified and claimed. The applicant
21 presents features of the present invention which are not found within the claims of
22 referenced patents. The applicant has presented law and argument to support the
23 contention that the rejection of under 35 U.S.C. 102 should be withdrawn and now
24 respectfully requests the Examiner to withdraw the rejections.
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Floyd E. Ivey in response to Office Action
of December 7, 2005

**Rejections under 35 U.S.C. 103(a) FROM OFFICE ACTION 10/18/04 AS
RESPONDED TO 3/18/05**

4. Comments re: Smith in view of Hannon: The Examiner states at page 4 paragraph 8 that Claims 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannon. The Examiner states that "Smith lacks a putter shaft...Hannon discloses a club being a putter....In view of the patent of Hannon it would have been obvious to modify the apparatus and club of Smith to include a putter in order to utilize the advantages of having two handles for swinging a club for a putter club.

First, Smith has been demonstrated to not anticipate your present invention. Further, the attributes described by the Examiner do not correspond to the attributes and structure of the present invention.

The Examiner's attention is drawn to the essence of the present invention. The "upper shaft (10)" of the present invention is not a "handle" to be grasped or which functions as a "handle" to assist in swinging a club or a putter. The "said upper shaft (10) having adequate length to contact the side of the player's neck;" functions as a training prompt and is not a handle to be grasped.

Smith teaches a "handle" to be grasped for swinging of the club. Hannon teaches a putter. Neither Smith or Hannon, separately or in combination, teach the training structure of your present invention. There is no motivation shown to combine Smith and Hannon.

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1 The rejection under Smith in view of Hannon has been addressed, the structure
2 and claims of Smith have been distinguished from your present invention. Claim 8 has
3 been amended. Neither Smith or Hannon, separately or in combination, teach, direct or
4 suggest the structure of claims 9-11 and there is no motivation shown to combine.
5 Accordingly, the Examiner is respectfully requested to withdraw the rejection under
6 Smith in view of Hannon and to allow claims 9-11.
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10 **5. Comments re: Smith in view of Hannon and further in view of Foresi,**

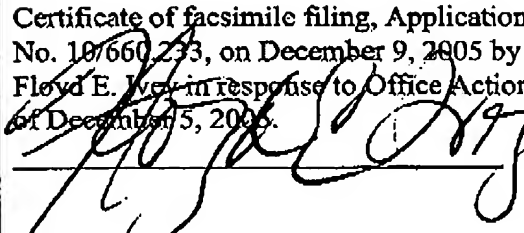
11 **Tucker and Cline:** The Examiner states at page 5 paragraph 10 that Claims 5, 12-14 are
12 rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Hannon and
13 further in view of Foresi, Tucker and Cline. The Examiner is referred to the comments
14 re: Smith in view of Hannon.
15

16 Claim 8 has been amended to state "said upper shaft (10) having adequate length
17 to contact the side of the player's neck;"
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19 The structure of Foresi and Smith have been distinguished from that of the present
20 invention. Smith in view of Foresi does not render the present invention obvious per the
21 preceding argument. Tucker discloses a clip. Cline discloses a clamp/clip tapering from
22 one end to the other.
23

24 It is respectfully submitted that Smith in view of Foresi and further in view of
25 Tucker and Cline does not teach, direct or suggest your present invention per claims 5 and
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1 12-14.

2 Accordingly, the Examiner is respectfully requested to withdraw the rejection
3 under Smith in view of Hannon and further in view of Tucker and Cline and to allow
4 claims 5 and 12-14.
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6 **6. Comments re: Sosin in view of Foresi, Smith, Hannon, Tucker and Cline:**

7 The Examiner states at page 7 paragraph 11 that Claims 5 and 7-14, all claims including
8 apparatus and method, are rejected under 35 U.S.C. 103(a) as being unpatentable over
9 Sosin in view of Foresi, Smith, Hannon, Tucker and Cline. Claim 8 has been amended to
10 state "said upper shaft (10) having adequate length to contact the side of the player's
11 neck;"
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13 The Examiner states that Sosin discloses a method of putting by positioning an
14 upper end of a shaft in contact with a golfer's neck and retaining the upper shaft in
15 contact with a golfer's neck through out the stroke (claim 1). Your applicant respectfully
16 understands that the reference here to "(claim 1)" is to that of Sosin in that Claim 1 of
17 your applicant's application has been cancelled in the Applicant's Amendment and
18 Response of 8/12/04.
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21 The Examiner's attention is respectfully drawn again to Sosin. The word neck is
22 not found in claim 1. Claim 1 of Sosin is a method which places the golf shaft on the
23 golfer's shoulder. The Examiner will see the claim of a method of claim 1 is:
24

25 A method of putting, comprising:
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2 addressing a golf ball in a sidesaddle stance;
3 swinging a puffer having an elongated shaft; controlling the putter during the
4 putting swing from at least three points of contact, wherein said at least three
5 points of contact comprises;
6 the contact points of both hands, and
7 the contact point of the shaft on a golfer's shoulder. "

8 The word neck, in Sosin, is found with reference to a bend in the neck of the club,
9 proximal the club head, as shown in Fig. 8. Claim 1 of Sosin, a method claim, is
10 distinctly distinguished from the method Claim 7 of the present invention which states:

11 7. (Previously amended) A method of training a golfer in putting or of putting by
12 means of the golf putter training apparatus of claim 13 comprising the steps of:
13 a. receiving the upper shaft 10 at the grip clip (40) via the grip clip slot (42) by
14 the putter lower shaft intermediate the putter head (100) and the golf putter
15 grip (75) and moving the upper-shaft (10) to grip affixing means contact of the
16 grip clip (40) with the golf putter grip (75);
17 b. affixing the angular relationship (110) between the putter lower shaft (72)
18 and the upper shaft (10) by adjusting the hinge means (42);
19 c. positioning the upper shaft first end (20) in contact with the golfer's neck (21);
20 d. training the golfer to execute the proper putting stroke and or making a putting
21 stroke by the golfer sensing and retaining the upper shaft first end (20) in contact
22 with the golfer's neck (21) throughout the putting stroke.

23 It is respectfully submitted that the method of Sosin, having a "contact point of the
24 shaft on a golfer's shoulder." teaches away from the apparatus of your present invention
25 at claim 8 and the method claim at claim 7.

26 It has been shown that the structures of Foresi and Smith are distinguished from
27 the structure of the present invention. Additionally, the present invention was not found
28 obvious in view of, Hannon, Tucker and Cline.

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30 No. 10/660,233, on December 9, 2005 by
31 Floyd E. Ivey in response to Office Action
32 of December 5, 2005.

1 The rejection under Sosin in view of Foresi, Smith, Hannon, Tucker and Cline
2 has been addressed, the structure and claims of Foresi and Smith have been distinguished
3 from your present invention. Claim 8 has been amended. Sosin teaches away from the
4 present invention. Sosin, Foresi, Smith, Hannon, Tucker and Cline, separately or in
5 combination, do not teach, direct or suggest the structure or method of claims 5 and 7-14.
6 Additionally, there is no motivation shown to combine. Accordingly, the Examiner is
7 respectfully requested to withdraw the rejection and to allow claims 5 and 7-14.
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11 **LAW REGARDING 35 U.S.C. 103,**

12 The absence of a feature similar to the feature or features of the present invention
13 are respectfully argued as references which teach away from the disclosed and claimed
14 invention and thus are not appropriately a basis of rejection under 103. *In re Gurley* 27
15 F.3d 551 at 553(1994 cafc). In general a reference will teach away if the line of
16 development flowing from the references disclosure is unlikely to be productive of the
17 result sought by the applicant. The disclosures and claims of the cited prior art,
18 separately, in combination and in view of, do not flow toward the invention of your
19 present applicant. The prior art cites do not teach, direct or suggest the structural
20 characteristics or the method of the present invention. The structure of your applicant's
21 invention as disclosed and claimed is not taught and the structures of the prior art cited
22 flow toward other compositions differing from that of your application.
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1 The Examiner has urged prior art alone and in combination as rendering obvious
2 the present invention. However, there is not demonstrated teaching, suggestion or
3 motivation to so combine the several components in the manner done by your present
4 applicant. Such recitation of prior art does not form a basis for rejection as obvious. *In*
5 *re Kotzab*, 217 F.3d 1365, 1369-70 (C.A.Fed. 2000); *C.R. Bard, Inc. v. M3 Systems, Inc.*,
6 157 F.3d 1340, 1361, 48 USPQ2d 1225, 1240 (Fed. Cir. 1998), rehearing denied &
7 suggestion for rehearing in banc declined, 161 F.3d 1380 (Fed. Cir. 1998) ("The ultimate
8 question is whether, from the evidence of the prior art and the knowledge generally
9 available to one of ordinary skill in the relevant art, there was in the prior art an
10 appropriate teaching, suggestion, or motivation to combine components in the way that
11 was done by the inventor."); *Chiuminatta Concrete Concepts, Inc. v. Cardinal Industries,*
12 *Inc.*, 145 F.3d 1303, 1312, 46 USPQ2d 1752, 1759 (Fed. Cir. 1998) ("for a claim to be
13 invalid for obviousness over a combination of references, there must have been a
14 motivation to combine the prior art references to produce the claimed invention."); *Kahn*
15 *v. General Motors Corp.*, 135 F.3d 1472, 45 USPQ2d 1608 (Fed. Cir. 1998), cert. denied,
16 119 S. Ct. 177 (1998); *Fromson v. Anitec Printing Plates, Inc.*, 132 F.3d 1437, 1447, 45
17 USPQ2d 1269, 1276 (Fed. Cir. 1997), cert. denied, 119 S. Ct. 56 (1998) ("there is no
18 suggestion or teaching in the prior art to select from the various known procedures and
19 combine specific steps, along with a new electrical structure, in the way that is described
20 and claimed by [the patentee]."); *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110

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1 F.3d 1573, 1578-79, 42 USPQ2d 1378, 1383, 1384 (Fed. Cir. 1997) ("the record must
2 provide a teaching, suggestion, or reason to substitute computer-controlled valves for the
3 system of hoses in the prior art. The absence of such a suggestion to combine is
4 dispositive in an obviousness determination."; "Without a suggestion or teaching to
5 combine, [the accused infringer's] case of obviousness suffers a significant deficiency.");
6 *Kolmes v. World Fibers Corp.*, 107 F.3d 1534, 1541, 41 USPQ2d 1829, 1833 (Fed. Cir.
7 1997) (the district court did not err in holding the patent in suit not invalid for
8 obviousness; the patent concerned a cut-resistant yarn for use in making products such as
9 gloves, which, unlike prior art yarns, did not use metallic components such as wire; the
10 yarn includes two core strands wrapped in opposite directions around two covering
11 strands; one core strand is fiberglass; the other core strand and the covering strands are
12 nylon or other material; the patent's claim required, inter alia, that there be a two strand
13 core and that the covering strands be "wrapped about said core at the rate of 8-12 turns
14 per inch."; a prior art reference showed a yarn with a wrapping rate of 2-24 turns per inch,
15 but the reference disclosed the use of wire, and the accused infringer "has shown no
16 suggestion or motivation to modify the teaching of the [reference] with regard to
17 non-metallic fibers."); *Litton Systems, Inc. v. Honeywell, Inc.*, 87 F.3d 1559, 1568, 39
18 USPQ2d 1321, 1327 (Fed. Cir. 1996) ("[N]one of the prior art references, alone or in
19 combination, teach or suggest a method [specified in the patent's claims]. The prior art
20 simply does not contain many limitations in the claimed method. Furthermore, the record
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1 discloses no teaching or suggestion to combine any of these references. The absence of a
2 suggestion to combine is telling in an obviousness determination."); *B.F. Goodrich Co. v.*
3 *Aircraft Braking Systems Corp.*, 72 F.3d 1577, 37 USPQ2d 1314 (Fed. Cir. 1996),
4 discussed at N. 12.10(1) *infra*; *Pro-Mold and Tool Co., Inc. v. Great Lakes Plastics, Inc.*,
5 75 F.3d 1568, 37 USPQ2d 1626 (Fed. Cir. 1996); *Beachcombers, International, Inc. v.*
6 *WildeWood Creative Products, Inc.*, 31 F.3d 1154, 1161, 31 USPQ2d 1653, 1659 (Fed.
7 Cir. 1994) (the patent claims in suit were not obvious in view of the prior art because the
8 art did "not remotely suggest configuring" the device as required by the claim);
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10 *Heidelberger Druckmaschinen AG v. Hantscho Commercial Products, Inc.*, 21 F.3d
11 1068, 1072, 30 USPQ2d 1377, 1379 (Fed. Cir. 1993) ("When the patented invention is
12 made by combining known components to achieve a new system, the prior art must
13 provide a suggestion or motivation to make such a combination."). *Texas Instruments*
14 *Inc. V. U.S. Int'l Trade Comm'n*, 988 F.2d 1165, 26 USPQ2d 1018 (Fed. Cir. 1993) for
15 the proposition that obviousness is not supported where the references do not demonstrate
16 to combine to produce the invention as presently disclosed.
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20 The issue of viewing the present invention as a template is an inappropriate basis
21 for rejection on the basis of obviousness. The prior art "references in combination do not
22 suggest the invention as a whole claimed in the ... patent. Absent such a suggestion to
23 combine the references, respondents can do no more than piece the invention together
24 using the patented invention as a template." *Heidelberger Druckmaschinen AG v.*
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1 *Hantscho Commercial Products, Inc.*, 21 F.3d 1068, 30 USPQ2d 1377 (Fed. Cir. 1993
2 where the court held that "The motivation to combine references can not come from the
3 invention itself."
4

5 The applicant respectfully submits that the references, alone and in combination,
6 otherwise must constitute improper use of hindsight reconstruction. *In re Kotzab*, 217
7 F.3d 1365, 1371 (C.A.Fed. 2000); *In Re Pleuddeman*, 910 F.2d 823, 828, 15 US PQ2d
8 1738, 1742 (Fed. Cir. 1990); *In Re Mahurkar Patent Litigation*, 831 F.Supp. 1354, 28 US
9 PQ2d 1801 (N.D. Ill. 1993). The cases cited stand for the rule that decomposing an
10 invention into its constituent elements, finding each element in the prior art, and then
11 claiming that it is easy to reassemble these elements into the invention, is a forbidden ex
12 post analysis. The applicant submits that it is impermissible to use the claimed invention
13 as an instruction manual or template to piece together the teachings of the prior art so that
14 the claimed invention is rendered obvious. The references simply do not teach to
15 combine the requisite features of your applicant's invention. "Before the PTO may
16 combine the disclosures of two or more prior art references in order to establish Prima
17 Facie obviousness, there must be some suggestion for doing so, found either in the
18 references themselves or in the knowledge generally available to one of ordinary skill in
19 the art. (*In re Jones*, 958 F.2d 347, 351, 21 USPQ2d 1941, 1943-44 (Fed. Cir. 1992)).
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27 "Evidence of a suggestion, teaching, or motivation to combine prior art references may
28 flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in

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1 the art, or from the nature of the problem to be solved. *See Dembiczak*, 175 F.3d at 999,
2 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure
3 contained therein should be combined with another, *see Motorola, Inc. v. Interdigital*
4 *Tech. Corp.*, 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing
5 of combinability, in whatever form, must nevertheless be "clear and particular." *Id.*
6 *Dembiczak*, 175 F.3d at 999, 50 USPQ2d at 1617." *Winner International Royalty*
7 *Corporation v. Ching-Rong Wang*, 202 F.3d 1340(CAFC 2000).
8
9

10 The applicant respectfully requests the Examiner to withdraw the 103 rejections
11 in light of the argument, amendments and responses submitted.

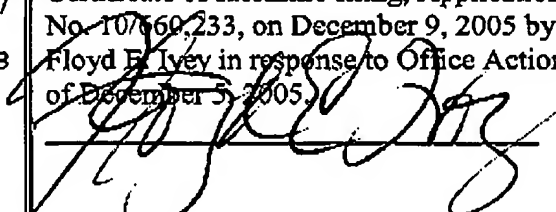
12 **OTHER PERTINENT MATTERS OF LAW-HINDSIGHT**

13 **RECONSTRUCTION:** It is respectfully submitted, in considering obviousness, that
14 hindsight reconstruction must be examined in addition to the 'function' comparison and
15 the 'known properties...' required by *Sussman*, *Id.* The court in *ATD Corp. v. Lydall,*
16 *Inc.* 159 F.3d 534, 546(C.A.Fed. (Mich.),1998) stated the following:
17
18

19 Obviousness is a legal conclusion based on underlying facts of four general
20 types, all of which must be considered by the trier of fact: (1) the scope and
21 content of the prior art; (2) the level of ordinary skill in the art; (3) the
22 differences between the claimed invention and the prior art; and (4) any
23 objective indicia of nonobviousness. *See Graham v. John Deere Co.*, 383 U.S.
24 1, 17-18, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966); *Continental Can Co. USA, Inc.*
25 *v. Monsanto Co.*, 948 F.2d 1264, 1270, 20 USPQ2d 1746, 1750 (Fed.Cir.1991);
26 *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561, 1566-68, 1 U.S.P.Q.2d
27 1593, 1595-97 (Fed.Cir.1987).

28 **Determination of obviousness can not be based on the hindsight
combination of components selectively culled from the prior art to fit the**

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1 parameters of the patented invention. There must be a teaching or
2 suggestion within the prior art, or within the general knowledge of a
3 person of ordinary skill in the field of the invention, to look to particular
4 sources of information, to select particular elements, and to combine them
5 in the way they were combined by the inventor. See *Heidelberger*
6 *Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068,
7 1072, 30 U.S.P.Q.2d 1377, 1379 (Fed.Cir.1994) ("When the patented
8 invention is made by combining known components to achieve a new
9 system, the prior art must provide a suggestion or motivation to make such
10 a combination."); *Northern Telecom, Inc. v. Datapoint Corp.*, 908 F.2d 931,
11 935, 15 U.S.P.Q.2d 1321, 1324 (Fed.Cir.1990) (the prior art must suggest to
12 one of ordinary skill in the art the desirability of the claimed composition);
13 *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 U.S.P.Q. 543,
14 551 (Fed.Cir.1985).(Emphasis Added)

15 We first look at the "known properties of the active ingredients" and compare
16 'functions in prior art with functions in the present invention'. If the prior art is sufficient
17 to show these characteristics then we move to the "hindsight reconstruction" analysis.
18 Does any prior art suggest the combinations presented by your applicant.

19 It is insufficient that prior art discloses components of a patented device, either
20 separately or in other combinations. Also "there must be some teaching, suggestion, or
21 incentive to make the combination made by the inventor.". Thus...[for obviousness the
22 Examiner] must have some evidence that the components claimed to be obvious both
23 existed at the time of your applicant's invention and combining them as your applicant
24 has done was suggested or taught by the prior art. *Aero Industries, Inc. v. John Donovan*
25 *Enterprises-Florida, Inc.* 80 F.Supp.2d 963, 974(S.D.Ind.,1999) citing *Northern Telecom*
26 *Inc. v. Datapoint Corp.* 908 F.2d 931, 934-35(C.A.Fed. Tex.1990).

27 The applicant respectfully requests the Examiner to withdraw the 103 rejections
28 in light of the argument, amendments and responses submitted.

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1 The applicant has set forth arguments and law for the basis upon which prior art
2 cited under 35 U.S.C. 103 should not result in a conclusion of obviousness for the present
3 invention as specified and claimed. The applicant has presented features of the present
4 invention which are not found within the claims of the referenced patents. The applicant
5 has presented law and argument to support the contention that the rejection of claims,
6 under 35 U.S.C. 103 should be withdrawn and now respectfully requests the Examiner to
7 withdraw the rejections.
8

9
10 **SUMMARY OF AMENDMENTS AND REMARKS REGARDING THE**
11 **REJECTIONS ADDRESSED IN THE AMENDMENT AND RESPONSE OF**
12 **3/18/05 IN RESPONSE TO THE OFFICE ACTION OF 10/18/04 RELATIVE TO**
13 **102 AND 103 REJECTIONS**
14

15 The applicant has reviewed the Examiner's Action of October 18, 2004, and has
16 addressed all objections and rejections under 35 USC 102 and 35 USC 103 disclosed
17 therein. Accordingly, the applicant has made a good faith attempt to meet each objection
18 and/or rejection as noted by the Examiner. The applicant has amended claims.
19 Accordingly your applicant requests the Examiner to withdraw the said objections and
20 rejections under 35 USC 102 and 103 and to allow the claims as set forth and as
21 amended.
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Rejections under 35 U.S.C. 112 FROM OFFICE ACTION 5/26/05 AS

RESPONDED TO 5/31/05

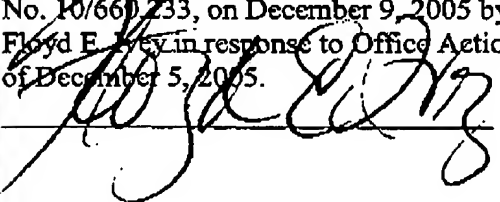
REMARKS REGARDING REJECTIONS AND AMENDMENTS TO THE CLAIMS

Claim Rejections under 35 U.S.C. 112 1. At page 2 of the Examiner's Action of 5/26/05 the Examiner has rejected Claims 5, 7 and 11-14 under 35 U.S.C. 112 as being indefinite. The Examiner states that the term "may" in lines 5 and 8 in claim 11 are indefinite in that it is uncertain whether the limitation being referred to is required or not. Claim 11 has been amended to strike "may be".

The Examiner states that the terms "equivalent materials" in claim 11 is indefinite. The terms "equivalent materials" in claim 11 has been stricken and amended at lines 8-9 to state "...plastics[,] and metals ~~and other equivalent materials~~; hinge means . . ." and amended at line 17 to state "... materials[,] and metals ~~and other equivalent materials~~."

The Examiner states, at page 2 that Claim 13 is indefinite in that in lines 4-5 it is uncertain what the statement "proximal the apparatus first end being greater than the grip clip second end dimension D2" means. Claim 13 has been amended to state "... and the golf putter grip dimension D4 (64), proximal the apparatus first end (20) being greater than the grip clip second end dimension D2 (62); ...". It is submitted that the phrase means that the golf putter grip dimension D4 (64), which is proximal the apparatus

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1 first end (20), is greater then the dimension of the grip clip second end dimension D2
2 (62).

3
4 At page 2-3, the Examiner states that claim 13 is indefinite in that the terms
5 "other forms" and "other similar" are indefinite and that it is uncertain what the limit of
6 this claim is to these elements of structure. Claim 13 has been amended to strike the terms
7 "other forms" and "other similar" as follows: ". . . b. the grip affixing means to affix the
8 grip clip means (40) also includes ~~other forms of gripping including a spring secured~~
9 clam shell structure allowing the grip clip means (40) to be opened to allow the grip clip .
10 . slot (65) to receive a golf putter grip (75) and ~~other similar friction affixing and or clamp~~
11 affixing structures."

12
13 The Examiner states at page 4 that Claim 14 is indefinite in that the statement
14 "the apparatus at the clip slot will receive either the apparatus shaft to slide up the
15 apparatus shaft toward the apparatus first end". It is respectfully noted that the phrase is
16 found in the specification at page 6, lines 4-8 where the following is found:

17
18 The apparatus (5) at the grip clip slot (65) will receive either the apparatus shaft
19 (10) to slide up the apparatus shaft (10) toward the apparatus first end (20) and
20 receive and be affixed at the golf putter grip (75) or the grip clip slot (65) will
21 receive the golf putter grip (75) and be affixed by affixing means for use in
22 putting.
23

24 It is respectfully submitted that the meaning is that the grip clip form which has
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1 a fixed clip slot dimension will fit over the tapered golf shaft proximal the second end
2 (90) and will slip up the shaft toward the first end (20) for a friction fit at the grip. An
3 alternative form of the grip clip having a spring secured clam shell form will be spring
4 operated and will directly be affixed to the putter grip (75).
5

6 The Examiner states at page 3 that Claim 7 is indefinite in that throughout the
7 claim it appears that the putter shaft is being referred to as reference number 10 which is
8 the apparatus shaft. Claim 7 has been amended as follows:
9

10 a. receiving the ~~upper shaft (10)~~ apparatus (5) at the grip clip (40) via the grip
11 clip slot (42) by the putter lower shaft (72) intermediate the putter head (100)
12 and the golf putter grip (75) and moving the ~~upper shaft (10)~~ apparatus (5) to
13 grip affixing means contact of the grip clip (40) with the golf putter grip (75); b.
14 affixing the angular relationship (110) between the putter lower shaft (72)
15 and the ~~upper shaft (10)~~ apparatus (5) by adjusting the hinge means (42);
16

17 At page 3 the Examiner states that reference numbers in claim 7 are without
18 parentheses. The amendment of claim 7 has remedied this lack of parentheses.
19

20 Your applicant respectfully submits that all 35 U.S.C. 112 rejections have been
21 addressed with claims 7, 11 and 13 amended and all rejections otherwise addressed by
22 comments and explanations. Your applicant has made a good faith effort to respond to the
23 said rejections, respectfully requests the Examiner to withdraw the rejections and to allow
24 the claims as amended.
25

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1 **SUMMARY OF AMENDMENTS AND REMARKS RE REJECTIONS UNDER 35**
2 **USC 112 FROM THE OFFICE ACTION OF MAY 26, 2005**

3 The applicant has reviewed the Examiner's Action of May 26, 2005 and has
4 addressed all 35 U. S .C. 112 rejections referred to therein. Accordingly, the applicant
5 has made a good faith attempt to meet each rejection as noted by the Examiner. The
6 applicant has amended claims. Accordingly your applicant requests the Examiner to
7 withdraw the said rejections and to allow the claims as set forth and amended.
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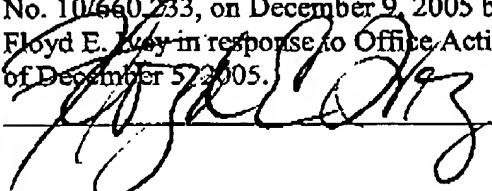
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12 **OFFICE ACTION OF JUNE 3, 2005**

13 The Office Action of June 3, 2005 was responded to by the applicant on June 7,
14 2005. By a prior paper the applicant had referred to cancelled claims 1-4 and 6 as
15 "withdrawn". The June 3, 2005 Action required the text of the claims 1-4 and 6 to be
16 entered. Responses to prior Office Actions has remedied the misnomer. The Examiner is
17 requested to withdraw the notice and allow the claims to be examined.
18
19

20
21 Respectfully Submitted,

22 
23 Floyd E. Ivey
24

25 Telephone No. (509) 735-3581
26

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CERTIFICATE OF TRANSMISSION:

The undersigned hereby certifies that this correspondence is being facsimile transmitted to Examiner Steve Blau, 703-308- 2712, Art Unit 3711, of the Patent and Trademark Office official Fax No., (703) 872-9306 on December 9, 2005.

Signature

Floyd E. Ivey

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